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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,656	02/04/2002	Jean Francois Bernat	PRINZ H1740	6951

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/067,656

Applicant(s)

BERNAT ET AL.

Examiner

Ross N. Gushi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-14 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4 and 15-18 is/are rejected.
- 7) ☐ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

This application contains claims drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 16, "said jack contact of a plug in jack" lacks antecedent basis and is confusing and unclear. The term is interpreted as meaning "the jack contact of the plug in jack according to claim 1."

Regarding claims 15 and 17, the term "SMT connection" is vague and ambiguous. Applicant does not define what the abbreviation means in the specification and merely indicates that the a "SMT connection" is or allows "a surface mounting technique." The term is interpreted as meaning the that the retaining part is capable of being mounted on a surface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jawelak in view of Evans. Jawelak discloses a plug in jack comprising a jack contact consisting of a retaining part 4 and a jack 2, said jack being mounted on the retaining part so as to be pivotable by a limited angle.

Jawelak does not discuss whether the contact is in an insulating jack housing. Evans discloses insulating jack housing 56 enclosing pin 52 mounted on circuit board 54. At the time of the invention, it would have been obvious to accommodate the Jawelak contact in an insulating housing as taught in Evans. The suggestion or motivation for doing so would have been to protect the contact from damage and prevent the contact from being accidentally shorted, as taught in Evans implicitly and as is well known in the art.

Per claim 2, said retaining part comprises a head portion, an adjoining annular groove and a collar adjoining said annular groove and wherein said Jack comprises spring shackles engaging with said annular groove.

Per claim 3, the shackles have free ends provided with one hook on each of the free ends.

Per claim 4, the jack is barrel shaped with is provided with contact shackles at an end opposite the hook.

Per claim 15, the retaining part is capable of being mounted on a surface.

Regarding claims 16 and 17, Jawelak does not show the details of the plug part except for the plug in portion 22. Evans discloses a plug in part including housing 56

and a contact capable of mating the jack contact discussed regarding claim 1, the plug contact including a plug in portion, and anchor portion and a surface mountable connection portion. At the time of the invention, it would have been obvious to use a plug part as disclosed by Jawelak with the jack part discussed regarding claim 1. The suggestion or motivation for doing so would have been to connect one device to another, as taught by Evans.

### ***Response to Arguments***

Regarding the term "SMT connection," applicant argues that the term is well known in the art. The examiner is not contesting whether the term is well known in the art. However, applicant has not defined what applicant means in particular by the term and the metes and bounds of the limitation is subject to various interpretations. Applicant argues that "elements adapted to Surface Mounting Technique are provided with contact pads which are soldered to corresponding contact pads on a printed circuit board . . . ." (Amendment filed 4/28/03, page 2, Remarks) Does the limitation of a "SMT connection" positively require contacts pads which are soldered to corresponding contact pads, per applicant's argument? The examiner has applied an interpretation that the term means the that the retaining part is capable of being mounted on a surface. Is applicant arguing that this interpretation of the term is overly broad? The examiner requests that the specification and claims be clarified to indicate whether the limitation means that contact pads are soldered on contact pads or whether it means that the retaining part is capable of being mounted on a surface. The examiner therefore maintains that the term is vague and ambiguous.

Applicant argues that Jawelak does not disclose a jack (amendment, page 3, paragraph 4). Jack normally means "a female fitting in an electric circuit used with a plug to make a connection . . . ." Merriam Webster's Collegiate Dictionary, 10th ed. 1998. Applicant argues that Jawelak is not a jack because it is formed of fingers arranged to form a cluster and "there is no mechanical connection between the contact fingers." Clearly, applicant is using a definition of "jack" which is narrower or at least different than the common definition of "jack." The examiner requests that applicant's applied definition of "jack" be made part of the specification and claims, so that one with ordinary skill in the art might be apprised of the meaning of the term as used by applicant. Given that applicant is using an unknown definition of "jack" the examiner is not persuaded that Jawelak does not disclose a "jack."

Applicant argues that the Jawelak device would not be pivotable. The examiner disagrees. The Jawelak fingers pivot in groove 44. As correctly noted by applicant, Jawelak states that the fingers may collapse or expand. The Jawelak fingers may all pivot in the same direction simultaneously. There is nothing in Jawelak that prevents one finger from moving toward the center and the opposite finger from moving outwardly. This would be the jack "pivoting" as the term is being used by applicant.

#### ***Allowable Subject Matter***

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 18 would be allowable if rewritten to overcome

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the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Regarding claims 5 and 18, the prior art does not suggest the assembly as claimed, including the combination of all the claimed elements, the combination including that the collar is adjoined by an anchor groove followed by an anchor portion, an annular spring being accommodated in the anchor groove, its edge facing the collar being beveled and a diameter of said collar and the head (or plug in portion) of said retaining part being less than a diameter of said anchor portion.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Garbini, Eriksson and Villiers et al. disclose pivotable jacks.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 308-7766

rng

A handwritten signature in black ink, appearing to read "Ross Gushi", with a stylized, flowing script.